

ESTTA Tracking number: **ESTTA647280**

Filing date: **12/29/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Universal Protein Supplements Corporation dba Universal Nutrition
Granted to Date of previous extension	12/31/2014
Address	3 Terminal Road New Brunswick, NJ 08901 UNITED STATES
Attorney information	Maureen Beacom Gorman Marshall, Gerstein & Borun LLP (31742-12282-L) 233 South Wacker Drive Suite 6300 Chicago, IL 60606 UNITED STATES mgorman@marshallip.com, kking@marshallip.com, cbeaker@marshallip.com

Applicant Information

Application No	86026728	Publication date	09/02/2014
Opposition Filing Date	12/29/2014	Opposition Period Ends	12/31/2014
Applicant	Fitness Publications, Inc. 3110 Main Street, Suite 300 Santa Monica, CA 90405 UNITED STATES		

Goods/Services Affected by Opposition


Class 005. First Use: 2013/10/02 First Use In Commerce: 2013/10/02
All goods and services in the class are opposed, namely: Dietary and nutritional supplements

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4483690	Application Date	01/08/2013
Registration Date	02/18/2014	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a human figure.
Goods/Services	<p>Class 005. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Nutritional supplements for human consumption</p> <p>Class 025. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets</p> <p>Class 035. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 On-line retail store services featuring health and diet-related products</p>

Attachments	<p>85817659#TMSN.png(bytes)</p> <p>141229 Bodybuilder Design Notice of Opposition.pdf(2030926 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Craig Beaker/
Name	Craig A. Beaker
Date	12/29/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Universal Protein Supplements Corporation,

Opposer,

v.

Fitness Publications, Inc.,

Applicant.

Serial No. 86/026,728

Opposition No. _____



Mark:

NOTICE OF OPPOSITION

Universal Protein Supplements Corporation (“Universal”), a New Jersey corporation with a primary place of business located at 3 Terminal Road, New Brunswick, New Jersey 08901, believes that it will be damaged by the registration of the above-referenced design shown in Application Serial No. 86/026,728 in connection with “Dietary and nutritional supplements” in Class 5 (the “Opposed Mark”), applied for by Fitness Publications, Inc. (“Applicant”), a California corporation with a place of business at 3110 Main Street, Suite 300, Santa Monica, California 90405.

Universal hereby opposes registration of the Opposed Mark, as shown in Application Serial No. 86/026,728, on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

In support of its Opposition, Universal states as follows:


Universal’s Prior Rights in the Bodybuilder Design Mark

1. Universal first used the bodybuilder design shown below in connection with nutritional supplements at least as early 1998. Since that time, Universal has adopted and continuously used the bodybuilder design in connection with nutritional supplements and related food products,

apparel, headwear, and online retail services featuring health and diet-related products (hereinafter the “Bodybuilder Common Law Marks”).



2. Universal also owns a federal trademark registration for the bodybuilder design on the Principal Register of the United States Patent and Trademark Office (“USPTO”), the details of which are included below:

Mark	Goods/Services	First Use In Commerce Date	Reg. No.	Status
	Cl. 5: Nutritional supplements for human consumption Cl. 25: Clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets Cl. 35: On-line retail store services featuring health and diet-related products	1998	4,483,690	Registered

The registration certificate for U.S. Registration No. 4,483,690, and the TSDR pages for the federal registration are attached hereto as Exhibit A (hereinafter the “Bodybuilder Design Registration”). Universal’s foregoing trademark registration and common law rights are hereinafter collectively referred to as the “Bodybuilder Design Mark.”

3. Universal has expended substantial sums of money in marketing, advertising, and promoting its Bodybuilder Design Mark and, through such sales and advertising, has generated substantial goodwill and customer recognition in its Bodybuilder Design Mark. As a result, the public has come to associate the Bodybuilder Design Mark exclusively with Universal.

4. Universal has derived substantial revenues from the sale of its products and services under the Bodybuilder Design Mark.

5. Universal's extensive use and advertising of the Bodybuilder Design Mark has resulted in consumer recognition that the Bodybuilder Design Mark identifies Universal as the source of products and services of high quality, including nutritional supplements. The Bodybuilder Design Mark is distinctive of Universal's products and services and are well-known, and valuable goodwill has been generated in the Bodybuilder Design Mark. Such goodwill was generated long before Applicant's filing date and alleged first use of the Opposed Mark on October 2, 2013.

Count I: Likelihood of Confusion
15 U.S.C. § 1052(d)

6. Opposer reasserts and incorporates Paragraphs 1 through 5 above as if fully set forth herein.

7. On August 1, 2013, long after Universal commenced use of the Bodybuilder Design Mark in association with Universal's products and services, Applicant filed Application Serial No. 86/026,728 in connection with "Dietary and nutritional supplements" in International Class 5, alleging first use dating back to October 2, 2013.

8. Applicant's Opposed Mark, when used on or in connection with the goods listed in Application Serial No. 86/026,728, is likely to cause confusion, mistake, or deception that Applicant's goods are those of Universal or are otherwise endorsed, sponsored, or approved by Universal, or cause confusion, mistake, or deception as to the affiliation, connection, or association between Applicant and Universal.

9. Universal believes that it would be damaged by the registration sought herein by Applicant because such registration would support and assist Applicant in the confusing and

misleading use of Applicant's Opposed Mark, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior superior rights of Universal.

10. Accordingly, Applicant's application to register the Opposed Mark must be refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended.

PRAYER FOR RELIEF

WHEREFORE, Universal prays that the Opposed Mark shown in Application Serial No. 86/026,728 be refused registration, and that this Notice of Opposition be sustained in favor of Universal.

Respectfully submitted,

Universal Protein Supplements Corporation

Dated: December 29, 2014

/mbgorman/

Maureen Beacom Gorman
Craig A. Beaker
MARSHALL, GERSTEIN & BORUN LLP
6300 Willis Tower
233 South Wacker Drive
Chicago, Illinois 60606
(312) 474-6300

CERTIFICATE OF SERVICE

I certify that this NOTICE OF OPPOSITION was served on Fitness Publications, Inc. by mailing a copy by first class mail, postage prepaid, to its attorney of record, David W. Grace, Loeb & Loeb LLP, 10100 Santa Monica Boulevard, Los Angeles, California 90067-4120.

Dated: December 29, 2014

/mbgorman/
Maureen Beacom Gorman

EXHIBIT A

United States of America

United States Patent and Trademark Office



Reg. No. 4,483,690

Registered Feb. 18, 2014

Int. Cls.: 5, 25 and 35

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

UNIVERSAL PROTEIN SUPPLEMENTS CORPORATION (NEW JERSEY CORPORATION),
DBA UNIVERSAL NUTRITION
3 TERMINAL ROAD
NEW BRUNSWICK, NJ 08901

FOR: NUTRITIONAL SUPPLEMENTS FOR HUMAN CONSUMPTION , IN CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 0-0-1998; IN COMMERCE 0-0-1998.

FOR: CLOTHING, NAMELY, HATS, CAPS, BOTTOMS, TOPS, SHORTS, PANTS, SHIRTS, SWEAT SHIRTS, SWEAT PANTS, SWEAT SHORTS, SWEAT JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 0-0-1998; IN COMMERCE 0-0-1998.

FOR: ON-LINE RETAIL STORE SERVICES FEATURING HEALTH AND DIET-RELATED PRODUCTS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 0-0-1998; IN COMMERCE 0-0-1998.

OWNER OF U.S. REG. NOS. 3,555,885 AND 3,568,919.

THE MARK CONSISTS OF A HUMAN FIGURE.

SER. NO. 85-817,659, FILED 1-8-2013.

ANGELA DUONG, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

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Mark:



US Serial Number: 85817659

Application Filing Date: Jan. 08, 2013

US Registration Number: 4483690

Registration Date: Feb. 18, 2014

Register: Principal

Mark Type: Trademark, Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Feb. 18, 2014

Publication Date: Dec. 03, 2013

Mark Information

Mark Literal Elements: None

Standard Character Claim: No

Mark Drawing Type: 2 - AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a human figure.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 02.01.02 - Men depicted as shadows or silhouettes of men; Silhouettes of men
02.01.19 - Men, athletes, strongmen; Golfer; Strongmen; Athletes (men)

Related Properties Information

Claimed Ownership of US Registrations: 3555885, 3568919

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Nutritional supplements for human consumption

International Class(es): 005 - Primary Class

U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: 1998

Use in Commerce: 1998

For: Clothing, namely, hats, caps, bottoms, tops, shorts, pants, shirts, sweat shirts, sweat pants, sweat shorts, sweat jackets

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: 1998

Use in Commerce: 1998

For: On-line retail store services featuring health and diet-related products

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: 1998

Use in Commerce: 1998

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Universal Protein Supplements Corporation

DBA, AKA, Formerly: DBA Universal Nutrition

Owner Address: 3 Terminal Road
New Brunswick, NEW JERSEY 08901
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where
Organized: NEW JERSEY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: MAUREEN BEACOM GORMAN

Docket Number: 31742/60001

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Correspondent

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Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 18, 2014	REGISTERED-PRINCIPAL REGISTER	
Dec. 03, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Dec. 03, 2013	PUBLISHED FOR OPPOSITION	
Nov. 13, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 30, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Oct. 29, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 03, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Oct. 03, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Oct. 03, 2013	ASSIGNED TO LIE	70884
Oct. 02, 2013	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Jun. 27, 2013	NOTIFICATION OF FINAL REFUSAL EMAILED	
Jun. 27, 2013	FINAL REFUSAL E-MAILED	
Jun. 27, 2013	FINAL REFUSAL WRITTEN	83695
May 23, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 23, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 23, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	

Mar. 13, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 13, 2013	NON-FINAL ACTION E-MAILED	6325
Mar. 13, 2013	NON-FINAL ACTION WRITTEN	83695
Mar. 13, 2013	ASSIGNED TO EXAMINER	83695
Jan. 17, 2013	NOTICE OF DESIGN SEARCH CODE MAILED	
Jan. 16, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 11, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Feb. 18, 2014